



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/532,766

04/26/2005

Takashi Kikuchi

1001 102

2690

95674

7590

07/07/2010

Adli Law Group P.C.
633 West Fifth Street
Suite 2600
Los Angeles, CA 90071

EXAMINER

HAIDER, SAIRA BANO

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,766	Applicant(s) KIKUCHI ET AL.	
	Examiner SAIRA HAIDER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/06/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimose (US 6,203,918).
3. Shimose discloses a laminate comprising a stainless steel base layer coated with polyimide layers and an electrical conductor layer (abstract). Wherein the polyimide layer reads on the claimed heat resistant adhesive and the electrolytic copper foil reads on the claimed metallic foil.
4. The laminate is formed by contact-bonding the layers in a vacuum press at 330°C (example 1). Shimose exemplifies a polyimide layer having a linear expansion coefficient of 22 ppm/°C, the electrical conductor layer is an electrolytic copper foil (which is recognized in the art as having a linear expansion coefficient of 18 ppm/°C) and the stainless steel base layer has a linear expansion coefficient 18.6 ppm/°C (example 1). Thus, the claimed coefficients of linear expansion in Shimose meets the claimed range of $\alpha_0 \pm 10$, specifically, the polyimide layer has a coefficient of linear expansion of $\alpha_0 + 4$, and the protective material has a coefficient of linear expansion of $\alpha_0 + 0.6$.
5. Claims 6-9 are recognized as product-by-process claims, wherein “[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Art Unit: 1796

6. The limitations regarding the film-like protective material disposed on the outside of the metallic foil (claims 6 and 9), wherein the film-like protective material is reusable (claim 9), are specifically recognized as product by process limitations. The prior art, Shimose, fails to disclose these limitations, however, determination of patentability is based on the product itself. Shimose discloses the claimed heat resistant flexible laminate comprising the heat resistant adhesive material and the metal foil. Shimose discloses that a stainless steel base layer is disposed between the metallic foil and the pressurized surface via the polyamide layers. Thus Shimose fails to disclose the claimed film-like protective material disposed on the outside of the metal foil at the time of lamination. However, since the prior art discloses the lamination of the claimed heat resistant adhesive to the metal foil via thermal lamination at the claimed temperature, the claimed product appears to be the same or similar to that of the prior art.

7. Wherein the claimed product appears to be the same or similar to that of the prior art, although produced by a different process. The examiner has provided a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP § 2113.

8. In reference to claim 8, regarding the dimensional change, Shimose discloses that upon etching "practically no deflection occurred." Additionally, since the prior art teaches the identical chemical compounds comprising the adhesive layer, metallic foil layer, and the protective material layer, the properties (heat resistance and dimensional change) applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note that because the reference

Art Unit: 1796

does not expressly address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Teaching the same compound(s) inherently discloses the corresponding properties. The references cannot possibly address all of the properties, but implicitly all of the properties are present.

Response to Arguments

9. Is it noted that the product-by-process quality of the claims was identified in the Final Office Action of 09/09/2008. In the response of 03/09/2009, applicant's noted that the temperature limitation claimed ("thermal lamination in a temperature range of not less than 200 degrees C") imparted a distinctive structure feature to the final laminate. The Shimose reference discloses the claimed temperature, and as noted above the prior art product is the same as the claimed product. In reference to the newly added limitations regarding the (reusable) film-like protective material, no structure is implied by the process involving the use of the film-like protective material. Nor has any evidence been provided that the manufacturing process steps involving the film-like protective material would be expected to impart distinctive structural characteristics to the final product. See MPEP 2113. Since the end product is the same in the prior art Shimose and the claims, even though produced by a different process, the burden shifts to applicant to come forth with evidence establishing an unobvious difference between the claimed product and the prior art product. See MPEP 2113.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1796

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

Saira Haider
Examiner

Application/Control Number: 10/532,766

Page 6

Art Unit: 1796

Art Unit 1796